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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,558	09/02/2005	Jorg Hacker	H&U122	9541
Marlana Titus Nash & Titus 6005 Riggs Road Laytonsville, MD 20882			EXAMINER JOIKE, MICHELE K	
			ART UNIT 1636	PAPER NUMBER
			MAIL DATE 05/26/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/525,558

Applicant(s)

HACKER ET AL.

Examiner

MICHELE K. JOIKE

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/NANCY VOGEL/
Primary Examiner, Art Unit 1636

Cont. of 11. Applicants argue that Trevors et al is a review article that describes several curing methods, which one of skill in the art would not have found sufficiently instructive, because none of the methods equate to the actual method that the inventors used. Trevors et al also teaches that curing plasmids is unpredictable and some plasmids cannot be cured. It discloses some choices for curing plasmids, but does not provide a predictable solution to achieve a plasmid-free DSM 6601.

Applicants also argue that Uraji et al only teach that their curing technique could also be applicable to other Agrobacteria. One cannot extrapolate that the method would work for other non-Agrobacterium species. If the method was applicable to other species, they would have stated so in their paper.

Lastly, Alexeyev et al do not teach using a tetracycline resistance cassette to cure plasmids.

Applicants' arguments have not been found to be persuasive for the following reasons.

As noted by the Applicant, Trevors et al teaches several curing methods. Applicants argue that their actual method is not taught by Trevors et al. Combined, Uraji et al, Blum-Oehler et al, Alexeyev et al and Trevors et al teach the claimed method. All of the steps are accounted for in the office action mailed on April 30, 2008. Uraji et al teach the main part of the curing method, Trevors et al was mainly used to teach the desirability of curing plasmids from bacteria. While Trevors et al teaches that some bacteria cannot be cured of plasmids, it also states the same can. While some experimentation may be involved, that does not mean it is unpredictable. Also, Trevors et al does not need to disclose a predictable solution for strain DSM 6601, otherwise Trevors et al would be used to reject the claims for lack of novelty. As for Uraji et al, there is no requirement that they list every species that could possibly be used in their method. The fact that they're silent about other bacteria does not mean the method will not work for other bacteria. In the paper, they teach delivery of plasmids from E. coli to Agrobacterium by conjugal transfer, so the bacteria are similar enough to transfer plasmids to each other. There is nothing in the paper to indicate that an E. coli strain would not work in a curing method, and Trevors et al show that curing plasmids works in E. coli. Alexeyev was used to teach use of a tetracycline cassette in a plasmid, not to teach a combination of steps leading to a plasmid-free DSM 6601 strain, or the strain itself. When combined with Blum-Oehler, Trevor and Uraji, the method is taught.